

U.S. Pat. App. No.: 09/859,565
Atty. Docket No.: 003797.00014

REMARKS

Applicants respectfully ask for reconsideration of both this application and the Office Action dated March 10, 2005. A response to this Office Action was due by June 10, 2005. Accordingly, Applicants are concurrently presenting a Petition for a three month extension of time, together with authorization to charge the associated petition fee, along with any other fees that may be necessary to maintain the pendency of this application (including any fees under 37 C.F.R. §1.16 and §1.17), to Deposit Account No. 19-0733. Please consider this Amendment as timely filed.

Claims 1-46 were pending in this application. Claims 1, 5, 9-12, 14-17, 19-22, 26, 30, 33, 36, and 39 are amended herein, while claims 24, 13, 18, 23, 27, 29, and 43-49 are canceled. More particularly, claim 1 is amended to incorporate the subject matter of canceled claims 4, 13, and 18, and claims 5, 9-12, 14-17, and 19-22 have been amended to correspond with the change to claim 1. Claim 26 then has been amended to incorporate a portion of the subject matter of claim 27, while claims 30, 33, 36, and 39 have been amended to recite that the software application includes a browser for retrieving and rendering content.

In the Office Action of March 10, 2005, the Examiner first rejected claims 1-3 and 23-25 under 35 U.S.C. §101, for purportedly being directed to non-statutory subject matter. In particular, the Examiner suggested that these claims are "not within the technological arts" because they recite processes that "do not apply, involve, use, or advance the technological arts." (See the Office Action, page 2, line 14 and page 3, lines 11-13). Applicants respectfully point out

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that this rejection is moot with regard to claim 23, as this claim is canceled herein. Further, Applicants courteously traverse this rejection as applied to claims 1-3, 24 and 25.

Applicants respectfully point out that claims 1-3, 24 and 25 recite publishing a core portion of electronic data, a first merchant-specific portion of the electronic data and a second merchant specific portion of the electronic data. First, Applicants submit that the step of publishing electronic data would involve and use technological arts. Second, the electronic data itself involves, and is for use with, technological arts. As described in the specification and recited in these claims, the electronic data includes a browser for retrieving and rendering content on a display or printout. Applicants therefore urge that claims 1-3, 24 and 25 clearly recite statutory subject matter under 35 U.S.C. §101.

Next, the Examiner rejected claims 1, 2, 4-23, 26, 27, 30, 31, 33, 34, 36, 37, 39 and 43 under 35 U.S.C. §102(b) over Web pages ostensibly¹ made available on the Internet by 1stUp.com over dates between November 2, 1999, and February 13, 2001, hereafter referred to as the "1stUp.com pages." Similarly, claims 3, 24, 25, 28, 29, 32, 35, 38, 40-42 and 44-46 were rejected under 35 U.S.C. §103 over the 1stUp.com pages. Applicants respectfully point out that these rejections are moot with respect to canceled claims 4, 13, 18, 23 as these claims are canceled herein. Applicants courteously traverse these rejections as applied to pending claims 1,

¹ Applicant points out that the 1stUp.com pages were not contemporaneously printed, but instead appears to be recently obtained from a Web site or search engine identified only as "Internet Archive - Way Back Machine." Applicants do not concede the historical accuracy of this Web site or search engine. Moreover, nothing in the 1stUp.com pages or the "Internet Archive - Way Back Machine" pages indicate that the 1stUp.com pages were actually publicly available more than one year prior to Applicants' filing date. Applicants therefore reserve the right to challenge the applicability of the 1stUp.com pages as prior art to the instant application.

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4-24, 26, 27, and 33-35, and ask for their reconsideration.

Claims 1-3, 5-12, 14-17, 19-22, 24 and 25 have been amended to recite that the core portion of the electronic data includes a browser that retrieves and renders content. This feature of the invention is not taught or suggested by the 1stUp.com pages.

Instead, the 1stUp.com pages appear to disclose a small application that is downloaded and used in conjunction with a conventional browser (i.e., a browser that does not evoke an association with a merchant). More particularly, the 1stUp.com pages generally disclose a business method whereby a sponsor provides free Internet access to a customer, in return for the customer continuously maintaining an "always-on" navigation bar with links to the sponsor's Web sites. (See, e.g., pages 6 and 9 of the 1stUp.com pages.) Applicants respectfully point out, however, that the 1stUp.com pages further disclose that the navigation bar is obtained by "the easy download of a small, 700k application." (*Id.*, page 11.) Thus, the 1stUp.com pages teach providing the navigation bar to the user separately from the browser software. Moreover, because the 1stUp.com pages teach an application specifically designed to be used with a conventional browser, Applicants submit that the 1stUp.com pages would actually teach away from the invention as recited in claims 1-3, 5-12, 14-17, 19-22, 24 and 25.

With regard to claims 26-29, Applicants respectfully submit that the rejections of claims 27 and 29 are moot, as these claims are canceled herein. Applicants respectfully traverse the rejections of pending claims 26 and 28, and ask for their reconsideration. Claim 26 is amended herein to recite that the second data field contains functionality branding that provides the core

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data with at least one function that evokes an association with a merchant. This feature is not taught or suggested by the 1stUp.com pages. Instead, these pages disclose only a conventional function of having the associated browser access a Web site specified by a sponsor or partner.

Regarding claims 30-42, Applicants respectfully traverse the rejections of these claims, and courteously ask for their reconsideration. Each of claims 30, 33, 36, and 39 are amended herein to recite that the software application includes a browser for retrieving and rendering content. As discussed in detail above, this feature is not taught or suggested by the 1stUp.com pages. Applicants therefore urge that the rejections of claims 30-42 be withdrawn.

Lastly, Applicants respectfully traverse the rejections of claims 43-46. In an effort to expedite prosecution of this application, however, Applicants have canceled these claims without prejudice or disclaimer. Applicants therefore submit that the rejections are now moot.

In view of the above amendments and remarks, Applicants respectfully submit that all of the claims are allowable, and that this application is therefore in condition for allowance.

Favorable action in this regard is courteously requested at the Examiner's earliest convenience.

Respectfully submitted,

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